

INTERFERENCE DIGEST

Interference No. 105,565

Paper No.

Name: Tat Hung Tong

Serial No.: 10/056,590

Patent No. 6,759,481, granted 07/06/04

Title: Shape memory styrene copolymer

Filed: 01/24/02

Interference with Mather et al.

DECISION ON MOTIONS

Administrative Patent Judge, _____ Dated, _____

FINAL DECISION

Board of Patent Appeals and Interferences, _____ Dated, _____

Court, _____ Dated, _____

REMARKS

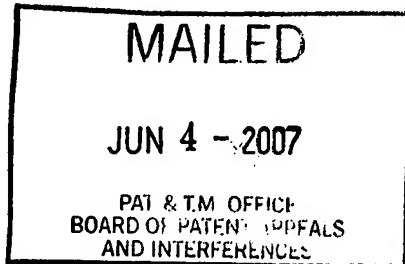
This should be placed in each application or patent involved in interference in addition to the interference letters.



PAPER NO.

UNITED STATES PATENT AND TRADEMARK OFFICE

DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES
BOX INTERFERENCE, WASHINGTON, D.C. 20231



Filed by: Judge Fred E. McKelvey
Telephone: 571-272-4683
Facsimile: 571-273-0042

Patentees: TONG
Application No.: 10/056,590, now Patent No.
6,759,481, granted 07/06/04
Filed: 01/24/02
For: Shape memory styrene copolymer

The above-identified application or patent has been forwarded to the Board of Patent Appeals and Interferences because it is adjudged to interfere with another application or patent. An interference has been declared. The interference is designated as No. 105,565.

Notice is hereby given the parties of the requirement of the law for filing in the Patent and Trademark Office a copy of any agreement "in connection with or in contemplation of the termination of the interference." 35 U.S.C. § 135(c).

/Fred E. McKelvey/
FRED E. McKELVEY
Senior Administrative Patent Judge

BoxInterferences@uspto.gov
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Paper 1
Entered: 4 June 2007

UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

Patent Interference 105,565 McK
Technology Center 1700

PATRICK T. **MATHER** and CHANGDENG LIU,

Application 10/425,451,
Junior Party,

v.

TAT HUNG TONG,

Patent 6,759,481 B2,
Senior Party.

DECLARATION

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Part A
Declaration of Interference

An interference is declared between the above-identified parties.
35 U.S.C. § 135(a); 37 CFR § 41.203(b).
Details for the application, patent, count and claims designated as
corresponding or as not corresponding to the count appear in Parts E and F
of this DECLARATION.

Part B
Judge Managing the Interference

Senior Administrative Patent Judge Fred E. McKelvey has been
designated to manage the interference. 37 CFR § 41.104(a).

Part C
Standing Order

A Trial Division STANDING ORDER (3 Jan. 2006) (Paper 2)
accompanies this DECLARATION.
The STANDING ORDER applies to this interference, including the
provisions related to Electronic Filing. See ¶ 105, pages 17-20.

1 **Part D**
2 **Initial Conference Call and Motions Lists**
3

4 Conference Call

5 A conference call to discuss the interference will be set only if Mather
6 can overcome the order to show cause (Paper 3) entered concurrently
7 herewith.

8
9 Motions Lists

10 Motions lists will be required only if Mather can overcome the order
11 to show cause (Paper 3) entered concurrently herewith.

12 If motions lists are ultimately required, each party shall serve a notice
13 stating the relief the party requests, *i.e.*, a motions list including motions the
14 party seeks authorization to file. 37 CFR § 41.120(a); STANDING ORDER
15 ¶ 204 (Paper 2, page 58).

16 The default procedure for filing and serving motions lists is that
17 motions lists are to be *filed* before being *served*.

18 By filing before service, one party will not have access to an
19 opponent's motions list prior to the filing of the party's motions list.

20 Nevertheless, the parties may mutually agree to discuss and serve
21 motions lists at any time prior to the date and time motions lists are due.

22 The following shall be included in motions lists.

23 (1) Proposed motion for benefit (*i.e.*, to be accorded an
24 earlier constructive reduction to practice) must identify the application(s) for
25 which benefit will be sought.

1 (2) Proposed motion to attack benefit must identify the
2 application(s) to be attacked.

3 (3) Proposed motion seeking judgment against an opponent
4 based on alleged unpatentability must identify the statutory basis for the
5 alleged unpatentability and:

6 (a) if based on prior art, identify the prior art;
7 (b) if based on the first paragraph of 35 U.S.C. § 112,
8 (i) identify whether written description, enablement or best mode will be the
9 basis for the motion, and (ii) briefly identify the basis for any alleged
10 unpatentability;

11 (c) if based on an alleged failure to comply with
12 35 U.S.C. § 135(b), briefly identify the reason;

13 (d) if based on the second paragraph of 35 U.S.C.
14 § 112, identify the limitation which is believed to be indefinite.

15 (4) Proposed motion based on no interference-in-fact shall
16 briefly identify the reason no interference-in-fact is believed to exist.

17 (5) Proposed motion to designate additional claims as
18 corresponding to a count or as not corresponding to a count shall identify the
19 claims involved.

20 (6) Proposed motion to add or substitute a new count shall
21 explain why the added or substitute count is necessary.

22 A motions list shall not contain any "reservation clause" whereby a
23 party purports to reserve a right to file additional motions. Additional
24 motions are those authorized by the Board consistent with the rules.

25 A sample schedule for taking action during the motions phase of the
26 interference appears as Form 2 (page 69) of the STANDING ORDER.

1 Counsel are encouraged to discuss the schedule prior to the
2 conference and agree to on times for taking action generally consistent with
3 the sample schedule.

4 A typical motions phase last about eight (8) months.

5 The parties should be prepared at the conference to justify any request
6 for shorter or longer time periods.

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Part E

**Identification of the Parties
Assignment of Exhibit Numbers
Initiating Settlement Discussions**

Junior Party

Inventors: Patrick T. Mather, CT
Changdeng Liu, CT

Application: Application 10/425,451 (IFW¹),
filed 29 April 2003

Title: Castable shape memory polymers

Real party in interest: None

Senior Party

Inventor: Tat Hung Tong, OH

Patent: U.S. Patent 6,759,481 B2
issued 06 July 2004,
based on application 10/056,950 (IFW),
filed 24 January 2002

Title: Shape memory styrene copolymer

Real party in interest: None

Assignment of Exhibit Numbers

Senior party: Exhibit Numbers 1001 through 1999.

Junior party: Exhibit Numbers 2001-2999.

Board: Exhibit Numbers 3001-3999.

¹ "IFW" means image file wrapper as opposed to a paper file wrapper.

1 Initiating Settlement Discussions
2 STANDING ORDER ¶ 126.1 (Paper 2, pages 40-41)
3

4 The senior party is responsible for initiating settlement discussions
5 required by the STANDING ORDER.

6 **Part F**
7 **Count and Claims of the Parties**
8

9 A shape memory polymer comprising a reaction product of
10 (1) styrene, (2) a vinyl compound other than styrene, (3) a multifunctional
11 crosslinking agent, (4) an initiator and (5) a modifying polymer.

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13 The claims of the parties are:

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15 Mather: 37-40

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17 Tong: 1-23
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19 The claims that correspond to Count 1 are:

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21 Mather: 37-40

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23 Tong: 1-23
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25 The claims that do *not* correspond to Count 1 are:

26
27 Mather: None

28
29 Tong: None
30

1 As to Count 1, the parties are accorded an earlier constructive
2 reduction to practice (*i.e.*, benefit for the purpose of priority) of the
3 following applications:

4 Mather: Provisional application 60/377,544 (IFW),
5 filed 02 May 2002

6 Tong: Provisional application 60/263,986 (IFW),
7 filed 24 January 2001
8

Part G
Heading to be Used on Papers

The following heading shall be used on all papers filed in this
interference [STANDING ORDER ¶ 106.11 (Paper 2, page 20)].

Filed by: [name of party] Paper _
[Name of attorney] Date filed: [enter date emailed to Board]
[Email address of attorney]
[Telephone number of attorney]

UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

Patent Interference 105,565 McK
Technology Center 1700

PATRICK T. MATHER and **CHANGDENG LIU**,

Application 10/425,451,
Junior Party,

v.

TAT HUNG TONG,

Patent 6,759,481 B2,
Senior Party.

Title of Paper, e.g., JONES SUBSTANTIVE MOTION 1

1 **Part H**
2 **Order Form for Requesting File Copies**

3 When requesting file copies, a party shall use STANDING ORDER
4 Form 4 (page 71).

5 Use of form 4 will expedite processing of any request.

6 a party should attach to any request for file copies a photocopy of
7 Part E of this DECLARATION with a hand-drawn circle around the patent
8 and application files for which a copy of a file wrapper is requested.

9 The parties are advised that a single order for file copies may be filled
10 by the Office of Public Records at more than one time. STANDING
11 ORDER ¶ 109.2 (Paper 2, pages 25-27).

12 **Part I**
13 **Required Paragraph of Affidavits and Declarations**
14
15

16 The Board has experienced cases in which a witness has belatedly
17 advanced reasons why the witness would be unable to appear for cross
18 examination at a reasonable time and place in the United States.

19 Consequently, to prevent surprise and hardship to the party relying on
20 the testimony of a witness, the following paragraph must be included on the
21 signature page of all affidavits (including declarations) filed in this case.

22 STANDING ORDER ¶ 157.2 (Paper 2, pages 52-53).

23
24 In signing affidavit (declaration), I understand that the affidavit
25 (declaration) will be filed as evidence in a contested case before
26 the Board of Patent Appeals and Interferences of the United
27 States Patent and Trademark Office. I also acknowledge that I
28 may be subject to cross examination in the case and that cross

1 examination will take place within the United States. If cross
2 examination is required of me, I will appear for cross
3 examination within the United States during the time allotted
4 for cross examination.
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9 /ss/ Fred E. McKelvey _____)
10 FRED E. McKELVEY)
11 *Senior Administrative Patent Judge*)
12
13

14 Entered at:
15
16 Kailua, HI
17 04 June 2007

1 cc: (via Federal Express)
2
3 Counsel for Mather
4 (real party in interest:
5 None)
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15 Counsel for Tong
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26 Email: None